

## REMARKS

Claims 1-3, 6, 8, and 10-39 are pending. Claims 1-3, 6, 8, and 10-39 were rejected. Dependent claim 30 has been amended to correct a minor typographical error in the claim number to which it refers. As amended, this rejection is respectfully traversed and reconsideration and allowance are requested.

Applicants would also appreciate the opportunity to have a telephonic interview with the Examiner before the next office action is issued and has filed a written request for it.

### *Claim Rejections – 35 USC § 103*

Claims 1-3, 6, 8, and 10-39 were rejected under 35 U.S.C. 103(a) as being unpatentable over US PAT 6,826,552 to Grosser et al. (Grosser) in view of US PAT 6,041,311 to Chislenko et al. (Chislenko). This rejection is respectfully traversed and reconsideration is requested.

#### *Claim 1*

Claim 1 is directed to an automated method for referring a prospective customer to automobile dealers. A database is queried to identify at least two dealers with whom the prospective customer has had prior contacts of different types. The prospective customer is delivered information about at least one of the located dealers, giving preference to the dealer or dealers with whom the customer had a prior contact of one of the types.

For example, the customer may have purchased an automobile from Dealer A and had it serviced by Dealer B. The database might contain information about both contacts. Nevertheless, the automated method might refer the customer to only Dealer A because the method might give preference to a prior sales contact over a prior service contact.

Neither Grosser nor Chislenko disclosed such a method, either alone or in combination.

Grosser was directed to computer aided decision-making. A user entered information about the user. *See* Col. 26, line 60 – Col. 27, line 28. The user specified a geographic area within which the user was willing to purchase a car. *See* Col. 28, lines 57-63. The system presented the user with a choice of dealers in that geographic area. *Id.* Information about the user was sent to a dealer selected by the user. *See* Col. 27, lines 36-44.

Grosser was thus an example of the typical prior art system that made referrals based on geographic location. It gave no consideration whatsoever to prior contacts that the prospective customer may have with dealers. In terms of the steps required by claim 1, Grosser did not disclose:

- (1) querying a database that contains contact information about prior contacts between prospective customers and dealers;
- (2) querying a database that contains contact information about the type of prior contacts between prospective customers and dealers;
- (3) locating within a database two or more dealers with whom a prospective customer has had prior contacts;
- (4) locating within a database two or more dealers with whom a prospective customer has had prior contacts of different types; or
- (5) delivering information to a prospective customer that gives preference to dealer(s) with whom the prospective customer has had prior contacts of one type.

Chislenko did not make up for any of these significant deficiencies in Grosser. Chislenko was directed to recommending items for purchase. *See Abstract*. The recommendations were based on profiles of users and profiles of the items. *Id*. However, Chislenko was not even concerned with referrals to dealers. And like Grosser, Chislenko gave no consideration whatsoever to prior contacts that a prospective customer may have had with dealers. In terms of the steps required by claim 1, Chislenko did not disclose:

- (1) querying a database that contains contact information about prior contacts between prospective customers and dealers;
- (2) querying a database that contains contact information about the type of prior contacts between prospective customers and dealers;
- (3) locating within a database two or more dealers with whom a prospective customer has had prior contacts;

(4) locating within a database two or more dealers with whom a prospective customer has had prior contacts of different types; or

(5) delivering information to a prospective customer that gives preference to dealer(s) with whom the prospective customer has had prior contacts of one type.

To be sure, the following is the complete text of the portions in Chislenko to which the Examiner cited:

Whenever a user profile is created, a number of initial ratings for items may be solicited from the user. This can be done by providing the user with a particular set of items to rate corresponding to a particular group of items. Groups are genres of items and are discussed below in more detail. Other methods of soliciting ratings from the user may include: manual entry of item-rating pairs, in which the user simply submits a list of items and ratings assigned to those items; soliciting ratings by date of entry into the system, i.e., asking the user to rate the newest items added to the system; soliciting ratings for the items having the most ratings; or by allowing a user to rate items similar to an initial item selected by the user. . . .

Col. 4, lines 1-13.

A weighted average of the ratings given to other items in the group can be used to recommend items both inside the group and outside the group. For example, if a user has a high correlation with another user in the "pop" grouping of music items, that similarity factor can be used to recommend music items inside the "pop" grouping, since both users have rated many items in the group. The similarity factor can also be used to recommend a music item outside of the group, if one of the users has rated an item in another group. Alternatively, a user may select a group, and a recommendation list will be generated based on the predicted rating for the user's neighboring users in that group.

Col. 11, lines 12-24. As can be seen, Chislenko did not disclose any of the five steps of claim 1 that are identified above.

Even in combination, Grosser and Chislenko did not disclose elements of claim 1.<sup>1</sup> For example, they did not disclose making referrals based on contacts that a prospective customer

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<sup>1</sup> Even the Examiner admitted that Grosser and Chislenko both failed to disclose the prior contact feature. *See* Office Action at p. 3, last paragraph ("There is no teaching in either Grosser or Chislenko to teach that the prospective customer must have had prior contact, thereby meeting the limitations as claimed").

may have had with dealers – one of the core contributions of the invention in claim 1. More specifically, they did not disclose in combination the following steps in claim 1:

- (1) querying a database that contains contact information about prior contacts between prospective customers and dealers;
- (2) querying a database that contains contact information about the type of prior contacts between prospective customers and dealers;
- (3) locating within a database two or more dealers with whom a prospective customer has had prior contacts;
- (4) locating within a database two or more dealers with whom a prospective customer has had prior contacts of different types; or
- (5) delivering information to a prospective customer that gives preference to dealer(s) with whom the prospective customer has had prior contacts of one type.

A claim may not be rejected as having been obvious where, as here, the combination of cited references did not disclose every limitation of the claim. *See, e.g.*, M.P.E.P. 2142 (“the prior art . . . references when combined [ ]) must teach or suggest all the claim limitations”).

The Supreme Court also recently made clear that an invention cannot be rejected as being obvious based on a combination of prior art references unless there was “an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR International Co. v. Teleflex, Inc.*, No. 04-1350, 2007 U.S. Lexis 4745 (April 30, 2007). “[T]his analysis should be made explicit,” the Supreme Court noted, citing with approval the statement by the Federal Circuit in *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) that “[r]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” The Supreme Court also indicated that examiners must be “cautious of [such] arguments” so as to not be “falling prey to hindsight bias.”

In this case, however, the Examiner has not articulated any reason for the skilled artisan to have combined Grosser with Chislenko, let alone one that was apparent. The Examiner has not even explained how these reference could have been combined.

In short, a *prima facie* showing of obviousness has not been made. The cited references did not disclose in combination all of the elements of claim 1, and no apparent reason has been offered for combining the steps that they did perform.

### ***Claim 23***

Claim 23 is directed to an automated method for referring a prospective customer to a dealer. Like claim 1, the method queries a database that contains information about prior contacts between dealers and prospective customer. If it locates a prior contact, a referral is made to the dealer that had the prior contact. If it fails to locate a prior contact, however, the process refers a nearby dealer. Thus, claim 23 gives preference to a dealer that has had a prior contact with the customer over a dealer that is merely nearby.

Even in combination, Grosser and Chislenko failed to disclose several steps of claim 23. These missing disclosures include:

- (1) querying a database that contains contact information about prior contacts between prospective customers and dealers;
- (2) locating a contact within a database between a prospective customer and a dealer;
- (3) reporting information about a dealer that had a prior contact with a prospective customer; and
- (4) failing to locate a contact within a database between a prospective customer and a dealer.

Again, a claim may not be rejected as having been obvious where, as here, the cited prior art did not disclose, even in combination, every limitation of the claim. *See, e.g.*, M.P.E.P. 2142.

And again, no apparent reason is offered by the Examiner for combining the relevant steps that these references did disclose. Again, an invention cannot be rejected as being obvious

based on a combination of prior art references unless there was an apparent reason to combine the known steps in the fashion claimed by the patent at issue.

***Claim 27***

Claim 27 is dependent upon claim 23 and thus is also not obvious in view of Grosser and Chislenko for the reasons discussed above in connection with claim 23.

Claim 27 also requires the querying to result in contacts with different dealers of different types and for the information that is given to the first customer to give preference to one of the types of contacts. Nowhere does the Examiner point to where this feature is disclosed in either Grosser or Chislenko, nor is it. Again, a claim may not be rejected as having been obvious where, as here, the cited prior art did not disclose, even in combination, every limitation of the claim. *See, e.g.*, M.P.E.P. 2142.

***Claim 38***

Claim 38 is directed to a system for referring a prospective customer to one or more sellers. The system includes a database system configured to look into a database to locate information about prior contacts the prospective customer has had with the sellers. It also includes a reporting system configured to provide information to the prospective customer about at least one of the sellers with whom the customer has had a prior contact, giving preference to the seller with whom the prospective customer has had a prior contact of one type when the customer has had prior contacts of different types with two or more of the sellers.

Again, nowhere does either reference disclose searching a database for contacts the customer has had with sellers, let alone giving preference in a reporting system to a prior contact of one type. Again, a claim may not be rejected as having been obvious where, as here, the cited prior art did not disclose, even in combination, every limitation of the claim. *See, e.g.*, M.P.E.P. 2142.

And again, no apparent reason is offered by the Examiner for combining the relevant features that these references did disclose. Again, an invention cannot be rejected as being obvious based on a combination of prior art references unless there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

***Claim 39***

Claim 39 is directed to a system for referring a prospective customer to one or more sellers. The system includes a database system configured to identify at least one seller with whom the prospective customer has had at least one prior contact and at least one seller that is near to the prospective customer. The system also includes a reporting system configured to provide information to the prospective customer about at least one of the identified sellers, giving preference to the seller with whom the customer has had a prior contact, if such a seller is identified by the database system.

Again, nowhere does either reference disclose searching a database for contacts the customer has had with sellers, let alone giving preference in a reporting system to a seller that has had a prior contact over a seller that is merely near the customer. Again, a claim may not be rejected as having been obvious where, as here, the cited prior art did not disclose, even in combination, every limitation of the claim. *See, e.g.*, M.P.E.P. 2142.

And again, no apparent reason is offered by the Examiner for combining the relevant features that these references did disclose. Again, an invention cannot be rejected as being obvious based on a combination of prior art references unless there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

***Claim 20***

Claim 20 is a system claim similar to amended claim 1. It too is not obvious in view of Grosser and Chislenko for reasons similar to those discussed above in connection with claim 1.

***Claims 2, 3, 24 and 25***

Claims 2, 3, 24, and 25 are dependent upon claim 1 or claim 23 and thus are also not obvious in view of Grosser and Chislenko for the reasons discussed above in connection with claim 1 or claim 23.

***Claim 26***

Claim 26 is dependent upon claim 23 and thus is also not obvious in view of Grosser and Chislenko for the reasons discussed above in connection with claim 23.

**Claims 6, 8, 9, 33**

Claims 6, 8, and 33 are dependent upon claim 1 or claim 23 and thus are also not obvious in view of Grosser and Chislenko for the reasons discussed above in connection with claim 1 or claim 23.

Claim 9 was canceled in the prior Amendment.

Claim 6 also requires the prior contact to which a preference is given to have been a selling relationship. The Examiner contends that it would have been obvious to have performed such a step, but fails to cite any prior art that allegedly disclosed it.

Applicants also pointed out the absence of such prior art in Applicants' last Amendment (mailed Jan. 2, 2007) and to the law that provided that an obviousness rejection was not proper without citation to prior art that at least disclosed every element of the claim. Although the Examiner continues to contend that this step was obvious, there is still no citation to any supporting prior art. Applicants again respectfully submit that this is not sufficient to create a *prima facie* case of obviousness. *See* M.P.E.P. 2144 ("It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.) Reconsideration is again requested.

To be sure, Applicants respectfully disagree that such a step was obvious. To Applicants' knowledge, there were no automated methods before Applicants' invention that made referrals based on the nature of prior contacts between the prospective customer and a group of potential dealers. Thus, it could not possibly have been obvious to have given preference to a prior sales relationship over another type of relationship in making such a referral. The fact that a customer may have had an opinion on a dealer that it visited, as noted by the Examiner, did not in any way render it obvious to have referred a customer to a dealer with whom the customer had a prior sales relationship over a dealer with whom the customer had a relationship of a different type.

Claim 8 requires that a lower preference be given to a prior contact that was a service relationship. The Examiner contends that it would have been obvious to have performed such a step, but again fails to cite any prior art that allegedly disclosed it.

Again, Applicants also pointed out the absence of such prior art in Applicants' last Amendment (mailed Jan. 2, 2007) and to the law that provided that an obviousness rejection was not proper without citation to prior art that at least disclosed every element of the claim. Although, the Examiner continues to contend that this step was obvious, there is still no citation to any supporting prior art. Applicants again respectfully submit that this is not sufficient to create a *prima facie* case of obviousness. *See* M.P.E.P. 2144 ("It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.) Reconsideration is again requested.

To be sure, Applicants respectfully disagree that such a step was obvious. To Applicants' knowledge, there were no automated methods before Applicants' invention that made referrals based on the nature of prior contacts between the prospective customer and a group of potential dealers. Thus, it could not possibly have been obvious to have given a lower preference to a prior service relationship over another type of relationship in making such a referral. The fact that a customer may have had an opinion on a dealer that it visited, as noted by the Examiner, did not in any way render it obvious to have referred a customer to a dealer with whom the customer had a prior relationship that was not a service relationship over a dealer with whom the customer had a service relationship.

Claim 33 also requires the information that is provided to the prospective customer to be divided into a plurality of sets, for each set to be of dealers that have had a contact with the prospective customer of a particular type, and for the sets to be displayed in order of a preference. The Examiner has not pointed out where this feature is disclosed in the prior art, nor provided any reason as to why the skilled artisan would have combined it with features in other prior art. To be sure, the fact that a customer may have had an opinion on a dealer that it visited, as noted by the Examiner, did not in any way render this feature obvious. Again, moreover, Applicants deny that this step was an obvious step.

#### ***Claims 10 and 28***

Claims 10 and 28 are dependent upon claim 1 or claim 23 and thus are also not obvious in view of Grosser and Chislenko for the reasons discussed above in connection with claim 1 or claim 23.

Claim 10 also requires a second round of prompting, receiving and querying in connection with a different prospective customer. Following this second round, and unlike following the first round, claim 10 requires that no prior contact information be found in the database. Instead, claim 10 requires that the different prospective customer be delivered information about at least one of the dealers that are near the different prospective customer. Claim 10 in combination with claim 1 (on which claim 10 depends) thus delineates a hierarchy of automated referral preferences. The process first checks to see if there are dealers that had prior contacts of different types. If this is found, information is provided giving preference to one of the contact types. If no prior contact information is found, preference is given to dealer(s) that are nearby. Although Grosser did return a list of nearby dealers, it did not disclose doing so only after a check failed to find any prior contact between the prospective customer and a dealer, as required by this claim. Indeed, even the Examiner admitted: "There is no teaching in either Grosser or Chislenko to teach that the prospective customer must have had prior contact, thereby meeting the limitations as claimed."

Again, a claim may not be rejected as having been obvious where, as here, the cited prior art did not disclose, even in combination, every limitation of the claim. *See, e.g.*, M.P.E.P. 2142.

### ***Claims 11 and 29***

Claims 11 and 29 are dependent upon claim 1 or claim 23 and thus are also not obvious in view of Grosser and Chislenko for the reasons discussed above in connection with claim 1 or claim 23.

These claims also require the results to be divided into a plurality of sets. Applicants respectfully disagree that the results in Grosser were inherently divided into a plurality of sets. The only inherent "results" that Grosser disclosed were the listing of geographic areas. However, a set is a combination of two or more items. Each geographic area, however, is merely one item. Thus a list of geographic areas is merely one set of items, not the division of a "plurality of sets" that is required by these claims.

Again, a claim may not be rejected as having been obvious where, as here, the cited prior art did not disclose, even in combination, every limitation of the claim. *See, e.g.*, M.P.E.P. 2142.

To be sure, Applicants deny that this feature was in any way obvious in view of the cited prior art.

***Claims 12 and 30***

Claims 12 and 30 are dependent upon claim 1 or claim 23 and thus are also not obvious in view of Grosser and Chislenko for the reasons discussed above in connection with claim 1 or claim 23.

Claims 12 and 30 also require the information that is provided to the prospective customer to be divided into a plurality of sets and for each set to be of dealers that have had a contact with the prospective customer of a particular type. The Examiner states that it would have been obvious "to include the prior contact with each set." However, these claims do not merely require the prior contact to be provided, but for information to be provided in sets and for each set to be dealers that have had a contact with the prospective customer of a particular type. Further, the Examiner has not pointed out where this feature is disclosed in the prior art, nor provided any reason as to why the skilled artisan would have combined it with features in other prior art. Applicants therefore respectfully submit that a *prima facie* case of obviousness has not been made out. To be sure, Applicants deny that this feature was in any way obvious in view of the cited prior art.

***Claims 13 and 31***

Claims 13 and 31 are dependent upon claim 1 or claim 23 and thus are also not obvious in view of Grosser and Chislenko for the reasons discussed above in connection with claim 1 or claim 23.

These claims also require one set of results to be viewed at a time. The Examiner states that this feature was disclosed in Grosser. Applicants respectfully disagree. All Grosser disclosed was to present a user with a list of geographic areas. Although the user may look at each entry in the list "at a time," a single entry is not a "set." Thus, this feature of these claims is not disclosed in any of the cited prior art.

Again, a claim may not be rejected as having been obvious where, as here, the cited prior art did not disclose, even in combination, every limitation of the claim. *See, e.g.*, M.P.E.P. 2142.

***Claims 14 and 32***

Claims 14 and 32 are dependent upon claim 1 or claim 23 and thus are also not obvious in view of Grosser and Chislenko for the reasons discussed above in connection with claim 1 or claim 23.

These claims also require one set of results to provide a link leading to the next possible set of results. Applicants respectfully submit that this feature was not disclosed in any of the cited prior art and was in no way obvious in view of any of the cited prior art. The fact that Grosser disclosed a “reject” icon is plainly not the same as a link to a next possible set of results. Nor did such a disclosure in any way render such a feature obvious. Indeed, Grosser did not even appear to have a next set of results.

Again, a claim may not be rejected as having been obvious where, as here, the cited prior art did not disclose, even in combination, every limitation of the claim. *See, e.g.*, M.P.E.P. 2142.

***Claim 15***

Claim 15 is dependent upon claim 1 and thus is also not obvious in view of Grosser and Chislenko for the reasons discussed above in connection with claim 1.

Claim 15 also requires sets to be displayed in order of a preference. Applicants respectfully disagree that this feature was disclosed in Grosser or obvious in view of it. First, Grosser did not disclose arranging its geographic locations in accordance with any preference relating to a type of prior contact. Nor was such an arrangement inherent. The dealers could just as easily have been listed in alphabetical order, in order of size, in order of inventory, or in any other order. Second, arranging geographic locations in accordance with a preference would not have been responsive to this claim element because the claim element requires “sets” to be displayed in order of a preference, not single items. Again, a claim may not be rejected where, as here, the cited prior art did not disclose all of its elements.

***Claims 16 and 34***

Claims 16 and 34 are dependent upon claim 1 or claim 23 and thus are also not obvious in view of Grosser and Chislenko for the reasons discussed above in connection with claim 1 or claim 23.

***Claims 17 and 35***

Claims 17 and 35 are dependent upon claim 1 or claim 23 and thus are also not obvious in view of Grosser and Chislenko for the reasons discussed above in connection with claim 1 or claim 23.

***Claims 18, 19, 36 and 37***

Claims 18, 19, 36, and 37 are dependent upon claim 1 or claim 23 and thus are also not obvious in view of Grosser and Chislenko for the reasons discussed above in connection with claim 1 or claim 23.

Claims 18 also requires preference to also be given to a dealer that had the most recent contact with the prospective customer over another dealer that previously had the same type of contact with the same prospective customer. Again, the Examiner claims that this step was obvious, but fails to cite any prior art that disclosed it. Again, a *prima facie* case of obviousness has not been established.

To be sure, Applicants deny that this feature was obvious in view of the cited prior art. To Applicants' knowledge, there were no automated methods before Applicants' invention that made referrals based on the existence of prior contacts between the prospective customer and a group of potential dealers. Thus, it could not possibly have been obvious to have given preference to a dealer that had the more recent contact of the same type. The fact that a customer may have shown an interest in a dealer did not render obvious the idea of making referrals based on the existence of prior contacts or giving preference to the most recent prior contact of the same type, as required by this claim.

Claims 19 and 37 are dependent upon claim 18 and thus are also not obvious in view of Grosser and Chislenko for the reasons discussed above in connection with claim 18. Claim 37 is also dependent upon claim 30 and thus is also not obvious in view of Grosser and Chislenko for the reasons discussed above in connection with claim 30.

Claims 19 and 37 also require highlighting the contact with the most recent date. Again, the Examiner claims that this step was obvious, but fails to cite any prior art that disclosed the step. Again, a *prima facie* case of obviousness has not been established.

To be sure, Applicants deny that this step was obvious in view of the cited art. To Applicants' knowledge, there were no automated methods before Applicants' invention that made referrals based on the existence of prior contacts between the prospective customer and a group of potential dealers. Thus, it could not possibly have been obvious to have highlighted the dealer that had the more recent contact of the same type. The fact that a customer may have shown an interest in a dealer did not render obvious the idea of highlighting the dealer that had the more recent contact.

Claim 36 is also dependent upon claim 30 and thus is also not obvious in view of Grosser and Chislenko for the reasons discussed above in connection with claim 30.

Claim 36 further requires the dealer with the most recent contact to be listed first. Again, the Examiner claims that the step is obvious, but fails to cite any prior art that disclosed it. Again, a *prima facie* case of obviousness has therefore not been established.

To be sure, Applicants deny that this step was obvious in view of the cited art. To Applicants' knowledge, there were no automated methods before Applicants' invention that made referrals based on the existence of prior contacts between the prospective customer and a group of potential dealers. Thus, it could not possibly have been obvious to have listed the dealer that had the more recent contact first. The fact that a customer may have shown an interest in a dealer did not render obvious the idea of listing the dealer that had the more recent contact first.

#### ***Claim 21***

Claim 21 is dependent upon claim 20 and thus is also not obvious in view of Grosser and Chislenko for the reasons discussed above in connection with claim 20.

#### ***Claim 22***

Claim 22 is dependent upon claim 20 and thus is also not obvious in view of Grosser and Chislenko for the reasons discussed above in connection with claim 20.

#### ***Conclusion***

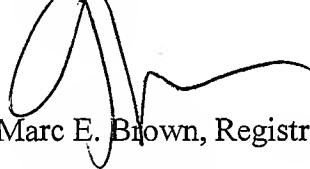
For the foregoing reasons, Applicants respectfully submit that this Amendment places this application in condition for allowance and early notice of the same is respectfully requested.

Applicants would appreciate the opportunity to have a telephonic interview with the Examiner before the next office action is issued and has filed a written request for it.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 501946 and please credit any excess fees to such deposit account.

Respectfully submitted,

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